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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,191	04/02/2001	Takeshi Shishido	35.C15262	7314

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
PADGETT, MARIANNE L	
ART UNIT	**PAPER NUMBER**
1762	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	09/822,191	SHISHIDO ET AL.	
	Examiner	Art Unit	
	Marianne L. Padgett	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/30/04 & 9/30/04*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5-15 and 19-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5-15,19-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 9/30/04 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The examiner notes that the "mail date" of the last action is "05/25/2004" on its coversheet and in the scanned file, however she questions whether this can be correct, since her records and the correction date at the end of that action indicate that it was not sent to scanning/ mailing until 6/02/2004. When required the action will be further referred to by its present official mail date.

2. A full translation of Shoichi Tanimura (JP 4-136175) has been received from translation, and is included herewith.

3. The objections to the specification and the 112, 2nd problems appear to have been corrected by amendment of 8/30/04 and replacement sheet of 9/30/04.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 5, 10, 15, 19 24 and 29-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5-8, 39, 41-42 and 44 of copending Application No. 10/776,173. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons set forth in section 6 of paper "mailed" 5/25/04. Applicants' argument that because the (176) application requires the narrower feature of a trap means, this is not obviousness double patenting is not convincing, since the present feature of heating like material of the chemical-reaction inducing means, requires no specific means of doing so, and as such encompasses and is read on by the specific filament limitation of (173). With respect to preventing plasma from reaching the chemical-reaction inducing means, while (173) may be treating plasma by products, the examiner saw no clear limitation therein of the plasma necessarily reaching the equivalent of the means, only some confusing language in 39 & 41 which might make it possible, doesn't necessitate it & could be plasma created by the filament. It is further note that plasma will prevented from traveling by bends in any exhaust piping & inherently attenuates with distance, so constitutes an obvious difference as previously argued.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1, 15 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda et al (JP 8-299784), in view of Tanimura Shoichi (JP 04-136, 177) or Chiba Hideshige et al (JP 08-218,174), as discussed in section 11 of paper mailed 5/25/04.

Applicants presented no arguments concerning this rejected, hence it stands uncontested. See p. 11 of response. Note translation of Tanimura, where the unreacted gas may came from a CVD thin film chamber (Fig. 1) or from plasma CVD (Fig. 5) to be treated in unreacted gas chamber 10, via thermal or plasma means, out of line of sight, which would have been expected to prevent any plasma in the exhaust from reaching the chamber. See p. 6-9.

7. Claims 5-14 and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda et al, in view of Tanimura or Chiba et al as applied to claims 1, 15, and 29-30 above, and further in view of Kanai et al (5,976,257), as applied on section 13 of the action of "5/25/04".

This rejection also stands uncontested.

8. With respect to Chiu (4,735,633) and Pang et al (6,194,628 B1), the inclusion of the list of specific metals from claim 4 or 18 into the independent claims removed the 102 rejections based on these claims, however it is noted applicant's arguments concerning these references on p. 12 of their 8/30/04 response confuse the claim of "heating..." with "using a heater, not a plasma" (response). The claims as written, do NOT require a heater *per se*, only something that can causing heating while inducing a chemical reaction. Plasmas inherently cause some heating, hence are not necessarily excluded from the process by the claim language, although applicant's

arguments appears to indicate that it was their intent to do so. Causing heating does not exclude plasma from occurring or visa versa.

9. Applicant's arguments filed 8/30/04 and 9/30/04, discussed above have been fully considered but they are not persuasive.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M L. Padgett whose telephone number is (571) 272-1425. The examiner can normally be reached on Monday-Friday about 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. L. Padgett/af
December 21, 2004
December 23, 2004

MARIANNE PADGETT
PRIMARY EXAMINER